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| 09/864,350      | 05/25/2001  | Martin Cullen        | P-3925-1            | 2355             |

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03/12/2007

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| EXAMINER |
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3723

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/864,350  
Filing Date: May 25, 2001  
Appellant(s): CULLEN, MARTIN

**MAILED**  
**MAR 12 2007**  
**GROUP 3700**

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Myron Amer  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 25 May 2005 appealing from the Office action mailed 24 September 2002.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claim 1.

Claim 2 is withdrawn from consideration as not directed to the elected invention.

Appellant petitioned for supervisory review of the withdrawal in a petition filed 04 November 2002. The petition was denied in a decision mailed 02 December 2002. Appellant did not file a request for reconsideration, nor present any arguments or evidence that would overcome the election by original presentation. Appellant states that the request for reconsideration is being made with the Appeal Brief.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is partly correct. The withdrawal of claim 2 as being directed to an invention non-elected based on original presentation is not an appealable matter, see for example MPEP 1201.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|           |                |        |
|-----------|----------------|--------|
| 4,428,159 | Sigetich et al | 1-1984 |
|-----------|----------------|--------|

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sigetich et al, 4,428,159. '159 discloses a ceramic tile shaping saw comprising a circular blade **33** having a peripheral cutting edge and of a diameter of at least 6 inches, (column 6, lines 50-55), motor means **31** connected to power the circular blade in rotation, a saw housing **21**, figure 3, having opposite ends, means **13** at one end for mounting the

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housing for pivotally traversing movement, means, figure 5, at the opposite end for journaling the circular blade for rotation in extending depending relation therefrom, a ceramic tile at least of a 6 inch square configuration, a tile support **57** in positioning relation beneath the tile and having an operative position located at an end of and in aligned relation to the path of the pivotal traversing movement of the housing. Note that the limitation beginning "a descending movement of the housing...whereby said shaping is achieved in an optimum nominal time than would have entailed making said cut from one end thereof to the opposite end thereof" is functional in nature. MPEP 2114 states in part: A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Here, '159 clearly teaches all of the structure of claim 1.

#### **(10) Response to Argument**

Regarding the withdrawal of claim 2 as being directed to an invention non-elected by original presentation, the examiner holds that this is a matter decided by petition. Appellant has not filed a request for reconsideration to the Director, within the two months allowed, as required by the petition decision mailed 02 December 2002. Therefore, the request for reconsideration must be considered untimely, and has not been considered by the examiner.

Regarding the rejection of claim 1, under 35 USC 102(b), appellant argues that claim 1 is structurally distinguished over the prior art applied, in that the invention

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requires a descending movement of the housing along the path of the pivotal traversing movement.... It is the examiner's position that the structure disclosed by Sigetich et al is clearly able to perform this movement, as the arm supporting the saw pivots about a horizontal axis, to perform a descending movement along the path of the pivotal traversing movement, the pivotal traversing movement being that movement that traverses the plane of the workpiece, as broadly claimed by appellant. Appellant has not recited limitations defining any particular pivot structure, or any particular structure that would require movement other than that claimed, and met by Sigetich et al. That appellant discloses a pivoting direction not shown by Sigetich et al is moot. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, In response to applicant's argument that the saw of Sigetich et al is not used in the same manner as claimed, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the structure of Sigetich et al is clearly capable of performing the intended use as claimed, and can perform a descending movement of the housing along the path of the pivotal traversing movement effective to establish the contacting by the cutting blade centrally of a start of a first proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in one direction incident to contact with a length portion of the cutting blade in

loading relation to the first cut and incident to contact with a length portion of the cutting blade in trailing relation to the first cut in an opposite direction until the tile is shaped into two parts, whereby the shaping is achieved in an optimum nominal time than would have entailed making the cut from one end thereof to the opposite end thereof. There is no structure in Sigetich et al that would prevent positioning the tile under the cutting blade, descending the housing along the path of the pivotal traversing movement to establish contact between the blade and the surface of the tile to cut the tile from a point on the tile and in opposite directions until the tile is in two parts. Further, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (MPEP 2114).

Appellant further argues that his position is supported by the precedent of In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523,1529 (Fed. Cir. 1998), that appellant states holds that on the issue of anticipation all limitations of a claim must be considered. The examiner agrees, and has in fact considered all the limitations.

Appellant further refers to Ex parte Hervy A. Morris, 1998 WL 1736155 (Bd.Pat.App & Interf.). The examiner agrees "there is nothing intrinsically wrong with defining something by what it does rather than what it is." In re Echerd, 471, F.2d 632, 635, 176 USPQ 321, 322 (CCPA 1973). In Morris , the prior art used to reject the claims did not contain structure that was capable of the claimed function. However, in this case, the examiner has given the claimed limitations their broadest reasonable

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interpretation, without reading limitations from the specification into the claims. The limitations directed to the use of the saw constitute a method of using the saw to cut a tile, and cannot be used to distinguish the structural claim over Sigetich et al. Further, without defining structure, the method of using the saw is not germane to the issue of patentability of the saw device itself. Sigetich et al discloses the structure as claimed, and there is no structure in Sigetich et al that would prevent it from being used as set forth in the use limitations of claim 1.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

M. Rachuba  
Primary Patent Examiner  
Art Unit 3723



Conferees:

Joseph Mail  


Derris Banks  
